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| 09/915,439   | 07/26/2001  | Rabindranath Dutta   | AUS920010440US1            | 7368             |
| 32329 7590 05/29/2008<br>IBM CORPORATION<br>INTELLECTUAL PROPERTY LAW<br>11400 BURNET ROAD<br>AUSTIN, TX 78758 |             |                      | EXAMINER<br>DASS, HARISH T |                  |
|  |             |                      | ART UNIT                   | PAPER NUMBER     |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/915,439  
Filing Date: July 26, 2001  
Appellant(s): DUTTA, RABINDRANATH

\_\_\_\_\_  
Frank C. Nicholas (Reg. # 33,983)  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 4/18/2008 appealing from the Office action mailed 10/31/2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

|                 |                 |         |
|-----------------|-----------------|---------|
| US 6,629,082    | Hambrech at al. | 09-2003 |
| US 6,691,094    | Herschhorn      | 02-2004 |
| US 2001/0034631 | Kiselik         | 10-2001 |

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hambrecht et al (hereinafter Hambrecht – US 6,629,082) in view of Kiselik (US 2001/0034631) and Herschkorn (US 6,691,094).

Re. Claim 1, 11, and 21 Hambrecht discloses a method, system and software, receiving a request for an enhanced certificate from a requestor at a **certificate authority** server [Figures 1-3B, 5-7C9 L47-L62; C12 L24-L48], receiving a bid from a purchaser with a purchaser enhanced certificate at the aggregate exchange server [C14 L59-L65], determining whether the bid matches the offer [C15 L48-L51], and receiving agreement of the matched supplier and purchaser at the exchange server to execute the transaction [C9 L48-L62; C31 L55-L60; C30 L58-L63].

Hambrecht does not explicitly disclose determining whether the requester qualifies for the enhanced certificate,

issuing the requestor the certificate if the requester qualifies,

receiving an offer from a supplier with a supplier certificate,

sending the supplier the purchaser enhanced certificate from the aggregate exchange server, and sending the purchaser the supplier enhanced certificate from the exchange server, if the bid matches the offer, and anonymous transaction.

However, Kiselik discloses determining (evaluation) whether the requester qualifies for the enhanced certificate (qualification information), issuing the requestor the certificate (see buyers and seller eligible or ineligibility) if the requester qualifies [see Figures 3, 4 and associated descriptions paragraphs 32-33], and receiving an offer from a supplier with a supplier certificate (see price quote), and sending the supplier the purchaser enhanced certificate (RFQ) from the aggregate exchange server, and sending the purchaser the supplier enhanced certificate (price quote) from the exchange server, if the bid matches the offer [see Figures 3, 4 and associated descriptions paragraphs 32-33 and 04, 36-37]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Hambrecht and include determining whether the requester qualifies for the enhanced certificate, issuing the requestor the certificate if the requester qualifies, receiving an offer from a supplier with a supplier certificate, and sending the supplier the purchaser enhanced certificate from the aggregate exchange server, and sending the purchaser the supplier enhanced certificate from the exchange server, if the bid

matches the offer, as disclosed by Kiselik, to provide a computer system to qualify buyers and seller based on buyer's and seller's profiles and match the buyer and seller based on the profiles for particular transaction. Neither Hambrecht nor Kiselik discloses anonymous transaction. However, Herschkorn discloses anonymous transaction [col. 3 lines 25-35, 54-65; col. 10 lines 45-62]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Hambrecht and Kiselik and include anonymous transaction, as disclosed by Herschkorn, to enable the trading party to trade with counterparty without disclosing his/her privacy or identification information in auction using internet website.

Re. Claims 2 and 12, Hambrecht discloses wherein the certificate authority server comprises the aggregate exchange server [C12 L24-L48; C23 L39-L62 – see network].

Re. Claims 4-5, , 14-15, & 22 Hambrecht discloses wherein issuing the requester an enhanced certificate comprises implementing at least one security feature, and wherein the security feature is selected from a group consisting of a user password, a public key cryptograph [C26 L39-L50; C24 L10-L15], a digital signature [C9 L48-L67]. Hambrecht does not explicitly disclose (5) an XML based security standard.

However, XML is well known used with Internet transaction. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify

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the disclosure of Hambrecht and include an XML based security standard to use standard acceptable security protocol known and used by others.

Re. Claims 3 and 13, Hambrecht discloses wherein the enhanced certificate comprises financial data and identification data [account information; C9 L48-L52; C13 L43-48]. Hambrecht does not explicitly disclose credit rating data, and financial routing data. However, these are well known. For example, to apply for credit, the lender (financial institution) obtains credit rating before providing credit. Similarly, financial data routing is used for electronic transfer of fund to buyer/seller accounts. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Hambrecht, Kiselik and Herschkorn to evaluate creditworthiness of buyer/seller and provide direct fund transfer to/from seller/buyer account.

Re. Claims 6-7, 16-17 and 23 Hambrecht discloses providing a hyperlink to the aggregated exchange server wherein the hyperlink comprises the certificate request, and wherein the hyperlink is provided on a web site for access by the requestor [C11 L54-L60].

Re. Claims 8-10, 18-20, and 24-25 Kiselik further discloses verifying a portion of requestor financial information with an outside server, and wherein verifying the portion of requestor financial information comprises determining eligibility for an enhanced certificate [see out side source paragraph 32] to obtain eligibility information from third

party such as Equifax for credit rating. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Hambrecht and include the above limitations to verify the eligibility of the traders by third party. Kiselik discloses updating requestor financial information [Abstract]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Hambrecht, Kiselik and Herschkorn and include updating requestor financial information to reflect the timely rating of the requestor.

#### **(10) Response to Argument**

In response to applicant's argument recitation (page 11) "Specifically, the references alone or in combination fail to teach or suggest "receiving agreement of the matched supplier and purchaser at the exchange server to execute the anonymous transaction" as claimed in claims 1, 11 and 21 ..."

Combination of Prior arts teaches this limitation (see Paper No. 20071028 page 2), **Primary reference Hambrecht (an analogous art) discloses receiving agreement of the matched supplier and purchaser at the exchange server to execute the transaction** [see at least the followings which discloses the limitation in question - Col. 1 lines 16-17 (auction system) Col. 9 line 48-62 (bidders); Col. 11 line 55 (transaction server 100); Col. 32 lines 35-59 ("company X offers to sell ... investors ... offers to purchase shares ... receive all the shares ..."); Col. 17 line 5 ("EXECUTED"); Col. 15 lines 37-57 ("Rather, the bid ... creates a contractual obligation ... to purchase the security post-execution clean-up after a deal has been completed. ... are matches



between bids and orders there have been no breaks in the system.); Col. 8 lines 1-7 (“execution ... cleaning and settlement”)).

Hambrecht explicitly does not teach anonymous transaction. A **secondary reference** **Herschkorn** (an analogous art) discloses the missing element of “anonymous transaction” (see Paper No. 20071028 page 42 lines 1-6) [see Figure 1; Col. 1 lines 6-10 (“a loan trading system ... over the Internet to match buyers and sellers ... auction.”); col. 3 lines 25-35, 54-65 (“cross-matching systems that allows users to trade with each other anonymously,” means anonymously trading is a prior art); col. 9 lines 45-62 (“As buyers and sellers may wish to maintain the anonymity ... prior to the matching ...”)]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Hambrecht and Kiselik (see Paper No. 20071028 page 3) and include anonymous transaction, as disclosed by Herschkorn, to enable the trading party (buyer or seller) to trade with counterparty (buyer or seller) without disclosing his/her privacy (maintain the anonymity) or identification information in auction using internet website.

Since the claimed invention is merely a combination of old elements (disclosed by Hambrecht, Kiselik, and Herschkorn), and in the combination each element merely would perform the same function as it did separately, and one of ordinary skill in the art would recognized that the results of the combination were predictable.

Note: reviewing of the disclosure of Hambrecht (primary reference) teaches that the investors are trading through underwriters and agents (brokerage firms) [col. 8 line 53 through col. 9 line 6]. Underwriter is represents an offering company (col. 2 lines 42)

which means that investors does not talk to the company, therefore company does not know the non-qualified investor and the user logins using PrefID and password, no where in disclosure the name of investor is mentioned disclosed to another party of transaction (see col. 15 lines 58-66; col. 22 line 67 through col. 23 line 2). This shows that there is a hint of anonymity but not explicitly disclosure of anonymity of traders.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., applicant's argument recitation (page 12) "While Hambrecht does not explicitly teach that the entity being formed with the capital formation needs to know the identity of the investors") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument recitation (page 14) "the Examiner cannot conclusively assert... considered impermissible hindsight." that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA

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1971). Further, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, see Herschkorn (Col. 3 lines 29-31 and Col. 4 lines 21-23) the auction is via websites and internet.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Harish T Dass/  
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